

Appl. No. : 09/575,403
Filed : May 22, 2000

SUMMARY OF INTERVIEW

Applicant's attorney Raymond B. Hom conducted a telephone interview with Examiner K. Pham on December 22, 2003. During the course of the interview, Applicant's attorney and the Examiner discussed proposed amendments to pending independent Claims 1, 9, 11, 13, 17, 19, 24, 27, 30, and 34. Additionally discussed were the references cited by the Examiner in the outstanding Office Action, Padwick, et al. ("Using Microsoft Outlook 2000") and U.S. Patent No. 6,243,725 to Hempleman, et al.

Applicant's attorney proposed claim amendments to add to the independent claims the feature that category property sets define data fields for a selected genre of audio or video content files. Applicant contends Padwick fails to teach or suggest these features. The Examiner agreed that "genre of audio or video content files" was not taught nor suggested by Padwick. However, the Examiner contends the combination of Padwick with Hempleman teaches the claimed features.

Applicant's attorney countered that there is no motivation to combine the teachings of Padwick with Hempleman. The Examiner agreed to consider this argument and indicated that further examination regarding this argument would be necessary. No conclusion was reached as to Applicant's arguments regarding the lack of motivation to combine the references.

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REMARKS

Discussion of Claim Objections

The Examiner objected to Claims 25 and 26 as depending from a subsequent numbered claim. Applicant has amended Claims 25 and 26 to be dependent from Claim 24. Applicant thus respectfully requests reconsideration and withdrawal of the claim objections.

Discussion of Rejections Under 35 U.S.C. § 102(a)

The Examiner rejected Claims 1-24 and 26-29 under 35 U.S.C. § 102(a) as being allegedly anticipated by Padwick, et al. ("Using Microsoft Outlook 2000"). The Examiner alleges the reference teaches each and every element of the claims.

Applicant respectfully submits that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. *See* M.P.E.P. § 2131.

Claim 1, as amended, recites a method for organizing and grouping metadata for display. The method includes "receiving a selection from a user of a category property set from a plurality of category property sets, wherein *each of the category property sets defines the data fields for a selected genre of audio or video content files.*" Claim 1 (*emphasis added*). The Padwick reference fails to teach or suggest at least this claimed feature. Padwick teaches organizing database entries, such as contact lists or calendar entries according to various fields. Nowhere does Padwick discuss storage of audio or video files nor does Padwick discuss different genres of content files. Thus, Padwick fails to teach or suggest how property sets define data fields for a selected genre of audio or video files. Indeed, the Examiner acknowledges in the Office Action that Padwick fails to teach metadata associated with media files such as audio or video files. Office Action, Sep. 25, 2003, page 11, last paragraph. Therefore, Applicant respectfully requests reconsideration and allowance of Claim 1 because Padwick fails to teach or suggest every claim limitation.

Applicant has similarly amended Claims 9, 11, 13, 17, 19, 24, and 27 to include reference to data fields related to audio or video files, or a genre of audio or video files. Thus, for the same reasons presented above in relation to Claim 1, Claims 9, 11, 13, 17, 19, 24, and 27 are not anticipated by Padwick because Padwick fails to teach each and every element of the claims.

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Applicant respectfully requests reconsideration and allowance of Claims 9, 11, 13, 17, 19, 24, and 27.

Discussion of Rejections Under 35 U.S.C. § 103(a)

The Examiner has also rejected Claims 25 and 30-37 under 35 U.S.C. § 103(a) as allegedly unpatentable over Padwick in view of U.S. Patent No. 6,243,725 to Hempleman, et al. (hereinafter Hempleman). The Examiner contends that it would have been obvious to combine the teachings of the two references, and the combination of references teaches each and every claim element.

In order to establish a prima facie case of obviousness, the prior art reference, or references, must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981 (CCPA 1974). Additionally, there must be some suggestion or motivation, either in the references themselves, in the nature of the problem being solved, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art and not based on Applicants' disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

Claims 30 and 34

Independent Claim 30 recites a method of modifying display groups and Claim 34 recites a program storage device storing instructions that when executed performs a method. The method of Claim 30 and the method performed when executing the instructions of the device of Claim 34 both include "providing a graphical user interface for allowing a user to create a type of data field to a display group that identifies metadata that is to be displayed with respect to a plurality of genres of media files."

The Examiner concedes that Padwick fails to teach or suggest providing "metadata that is to be displayed with respect to a plurality of media files." However, the Examiner contends that Hempleman teaches media files, and thus it would have been obvious to modify Padwick to include the claimed feature. Applicant respectfully disagrees with the Examiner's conclusion. Applicant submits that the prior art must suggest the desirability of the claimed invention. *See* M.P.E.P. § 2143.01. The fact that references *can* be modified is not sufficient to establish prima

facie obviousness. *Id.* Furthermore, the fact that the claimed invention is within the capability of one of ordinary skill in the art is not sufficient by itself to establish prima facie obviousness. *Id.* The Examiner merely identifies two references that disclose systems and methods that are similar to some of the claimed features and then concludes that it would be obvious to modify the teachings of the two references to produce Applicant's claimed invention. Applicant respectfully submits that the Examiner has not provided any basis for a motivation to modify or combine the teachings and thus, has not made out the prima facie case for obviousness.

Padwick teaches how to use the program Microsoft Outlook 2000. The program includes the ability to track such database items as a contact list and a calendar of tasks. However, Padwick fails to teach or suggest any manner in which media files can be classified. Additionally, Padwick fails to teach or suggest any manner in which the program can even store media files. Padwick also fails to teach or suggest any genres associated with stored files nor the ability to edit metadata types that are to be displayed with respect to a particular genre. Additionally, Padwick fails to teach or suggest expandability to any features not already included in the program.

Hempleman describes a system for managing music, wherein the user can create playlists, edit the content of predefined data structures describing the music, and play the music. Hempleman fails to teach or suggest that the types of data fields can be different depending on the selected category or that they are user configurable. Hempleman fails to teach different metadata types for different genres of music. Each category of music stored in the system of Hempleman includes the same metadata set, and the user has no ability to define a new metadata type. Additionally, Hempleman fails to teach or suggest how a display of data fields may be user configurable for user selected data field types.

Neither reference provides any motivation to create a system or method that embodies both the ability to store media files and "allowing a user to create a type of data field to a display group that identifies metadata that is to be displayed with respect to a plurality of media files." The description in Hempleman of a system of creating a music playlist from CDs is insufficient motivation to suggest to one of ordinary skill in the art to modify the program Microsoft Outlook 2000 to include the ability to store media files or to be able to create types of metadata for such media files.

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Padwick is a manual for how to use existing features of Microsoft Outlook 2000. It does not contemplate modifying the program nor does it suggest modifying the actual program to perform tasks that it was not designed to perform. One of ordinary skill in the art generally would not look to a user manual as motivation for modifying the actual program described in the user manual.

Thus, Applicant respectfully requests reconsideration and allowance of Claims 30 and 34, because the references fail to disclose any motivation for combining the features of the two references, and the combination of the references fails to teach or suggest all claimed features.

Dependent Claims 2-8, 10, 12, 14-16, 18, 20-23, 25-26, 28-29, 31-33, and 35-37

Claims 2-8, 10, 12, 14-16, 18, 20-23, 25-26, 28-29, 31-33, and 35-37 depend either directly or indirectly from one of Claims 1, 9, 11, 13, 17, 19, 24, 27, 30, or 34 and are thus believed to be allowable at least for the reason that they depend from an allowable base claim. Thus, Applicant respectfully requests reconsideration and allowance of Claims 2-8, 10, 12, 14-16, 18, 20-23, 25-26, 28-29, 31-33, and 35-37.

CONCLUSION

Applicant has endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. Accordingly, amendments to the claims for patentability purposes, the reasons therefor, and arguments in support of the patentability of the pending claim set are presented above. In light of these amendments and remarks, reconsideration and withdrawal of the outstanding rejections is respectfully requested. Applicant submits that the claim limitations discussed above represent only illustrative distinctions. Hence, there may be other patentable features that distinguish the claimed invention from the prior art.

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If there are any impediments to allowance of the claims that can be resolved with a telephone call, the Examiner is respectfully invited to call the undersigned. Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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Dated: Dec 23, 2003

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